

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: ROBERT BERGHASH and JEFREY L. FROST

Serial No.: 10/665,539

Examiner: MITRA ARYANPOUR

Filed: September 19, 2003

Art Unit: 3711

For: HAND SHIELD FOR HOCKEY STICK

AFFIDAVIT

COUNTY OF HENDRY)
) ss.:
STATE OF FLORIDA)

JEFREY L. FROST, being duly sworn, deposes and says:

1. I am an individual residing at 1659 Palm Lane, LaBelle, Florida 33935, and I am a co-inventor with Robert Berghash of the subject matter disclosed and claimed in U.S. Patent Application Serial No. 10/665,539 for a HAND SHIELD FOR HOCKEY STICK, filed September 19, 2003 (the "Application"). I have personal knowledge of all facts and circumstances stated herein unless otherwise indicated.

2. I have reviewed the provisional patent application filed by Eric Tyler, which was cited in the Examiner's March 8, 2005 Office Action in this matter. As I invented the subject matter disclosed and claimed in my application long before Tyler filed his provisional application on January 8, 2003, I have attached hereto various documents from my files and/or the files of the co-inventor, Robert Berghash, which demonstrate that the invention claimed in the Application was conceived of prior to January 8, 2003 and that I used reasonable diligence to

reduce the invention to practice between the time prior to January 8, 2003 and the date of my Application.

3. On April 17, 2002, I sent a letter and drawings to Sportime, LLC's Senior VP for New Product Development, Barry Traub. In that letter, attached as Exhibit A, I described a hand shield for a hockey stick which included a shield portion with a convex outer surface, and a flexible interior grip connected to the shield portion with an opening to receive a hockey stick. The drawings attached to my April 17, 2002 letter depict a hand shield with a shield portion (referred to as a "cup") having a generally rectangular opening (referred to as a "hole") to accommodate portions of a hockey stick. The drawings further disclose a flexible shield portion with a convex outer surface and an interior grip portion connected to the shield portion which extends away from the shield portion, configured to surround or embrace the hockey stick in a manner which would permit movement of the hand shield up and down the stick. The letter, drawings and instructions for the drawings clearly show that the flexible shield portion was configured to shield all or part of the user's hand.

4. Attached as Exhibit B is a copy of a letter I received from the President of Sportime, LLC of Atlanta, Georgia, dated May 9, 2002. I received a second letter from Sportime, dated June 4, 2003, in which Sportime declined to proceed with the manufacture of my hand shield. That letter is attached as Exhibit C.

5. Shortly thereafter, I was referred to Shield Mfg. Inc. ("Shield Manufacturing"), the assignee of my pending patent Application. Attached as Exhibit D is a copy of my July 10, 2002 letter and drawings to David Berghash at Shield Manufacturing. The letter recounts my telephone conversation with Mr. Berghash on July 9, 2002 wherein I

discussed with Mr. Berghash the hand shield invention. The letter itself discloses a plastic hand shield which may be slid on a hockey stick to protect the hands of hockey players from scrapes, bruises, etc.

6. The drawings attached to my July 10, 2002 letter to Shield Manufacturing are the same drawings which I sent to Sportime, as described above.

7. After July 10, 2002, I had several discussions with Robert Berghash, the co-inventor, exchanged several e-mails with him and cooperated in the development of several samples of the hand shield. As described in the attached e-mails from Mr. Berghash (Exhibit E), at least 2 samples were made by December 2, 2002, and additional samples were made for testing that month as well as drawings. Among other things, the second e-mail confirms the fact that the hand shield would be flexible or "semi-soft like Tupperware."

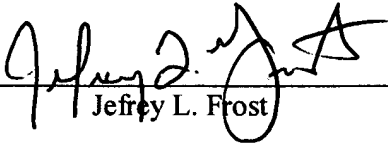
8. Between July 10, 2002 and the date the Application was filed, diligent efforts were made to design, develop and build preferred versions and samples of the hand shield, and to have the product and an injection mold for the product manufactured for sale. I understand that the mold was ordered in April 2003 and that the first sale by Shield Manufacturing of a hand shield covered by the pending claims was made in August 2003.

9. Attached as Exhibit F is a copy of my License Agreement with Shield Manufacturing, dated October 15, 2002, wherein I agreed to license the hand shield invention to Shield Manufacturing.

10. Based on my personal knowledge of the conception and development of the hand shield, I can say conclusively that the subject matter defined in the amended claims filed December 16, 2004 were conceived of many months prior to the date of the Tyler

provisional application, and that reasonable diligence was used to reduce the hand shield to practice between at least July 2002 and August 2003 when a product covered by the patent was first sold by Shield Manufacturing.

Sworn to before me this
2nd day of ~~July~~ August, 2005.



Jeffrey L. Frost



Notary Public



Dear Mr. Traub,

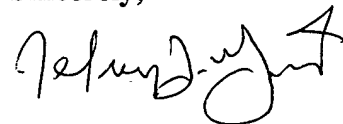
Several years ago I came up with the idea of a safety add on for Floor Hockey sticks. To say it has been on the back burner would be an understatement, forgot about it for a while would be more accurate. I have noticed your company's recent focus on innovations, and thought I have nothing to lose by submitting my idea.

From years of playing Floor Hockey in Public School Physical Education classes, and now as a Physical Education teacher (fifteen years middle and high school) I frequently see there should be some kind of hand protection. Most importantly for the bottom hand holding the stick. All too often during play while two opposing players are going for the puck (or ball) one stick will ride up on the other and hit the player in the hand (usually causing a scrape or bruise on the finger(s) and or knuckle). Besides the obvious pain a player (student) endures, you also have those students who will be reluctant to participate because of this problem.

It is my proposal for you to make a low cost, plastic cup (or similar device) that can be used for both safety and as a guideline for hand placement. The cup can be simply screwed on (like a new blade) at an appropriate length on the stick (for the lower hand) according to age level by the teacher. This "add on" would be simple and safe.


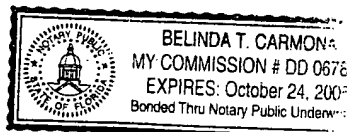
Also, I noticed in your last catalog that you now offer protective gloves at ~ \$30.00 a pair. With the limited Physical Education budgets available today, it would cost almost \$300.00 to outfit two teams (and that does not include the goalies). At a cost of perhaps one-third or more of that of the gloves, this shield (as yet unnamed) would be more economical for use in today's Physical Education and Recreation classes.

Sincerely,

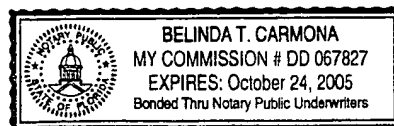


Jefrey L. Frost
Teacher/Coach
LaBelle High School
4050 Cowboy Way
LaBelle, FL 33935
(863) 674-4120

Signed before me this 16th day of April,
2002.


Notary Public

(Enclosed please find a rough sketch of the "Cup" and alternate shield design with instructions. Thank you for your time in review and consideration of my idea.)



Instructions for Diagrams
(Not to size or scale)

Diagram A: FRONT VIEW of "Cup" simply shows hole for stick. It also shows a hole at its base large enough for a standard screwdriver to fit through. SIDE VIEW of "Cup" shows a see through view of inside piece that attaches to the Hockey Stick by a screw.

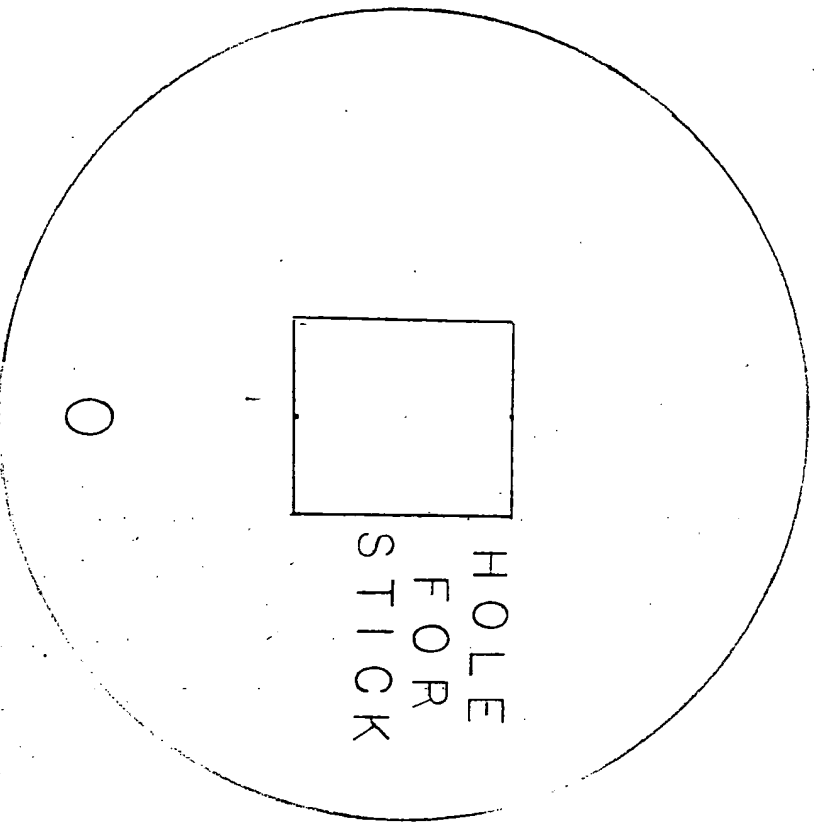
Diagram B: BACK VIEW again shows hole for Hockey Stick, hole for screwdriver and, straight on view of inside attachment to be screwed to stick. BOTTOM VIEW shows cut away view of cup, showing inside piece of cup that is screwed on to Stick.

The "cup" could be slid over the back end of the stick. Another possibility would be to separate (cut) the lower half of the "Cup" and simply slide it over the back of the stick and securely refasten it back together and to the stick.

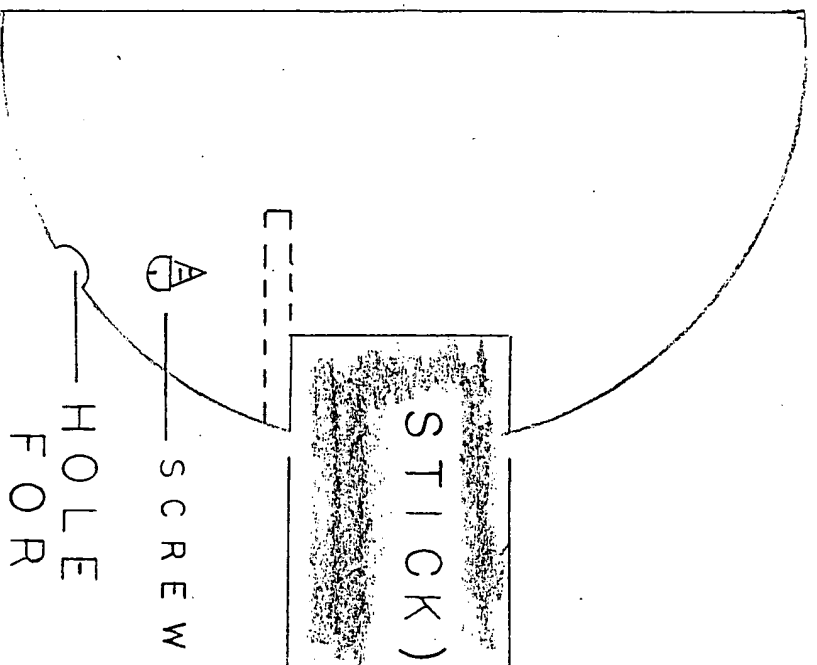
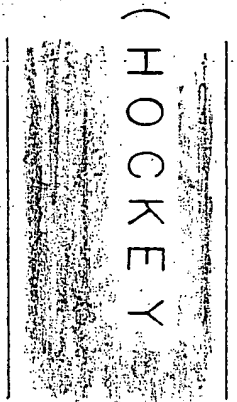
Lastly, I think a minimum diameter for the cup or shield should be about 6-7 inches across to protect the hand and knuckles.

Diagram C: SIDE VIEW shows a one-piece flexible rubber grip with small shield in front that can be slid over the back end of a Hockey Stick. It would fit snugly on the stick, and would be slid down (may need to add water for lubrication) to the appropriate spot. FRONT VIEW simply shows the front view, with cut out of handgrip. Note that the shield part of this piece is flat and not curved like the "Cup" in Diagrams A and B.

(DRAWINGS NOT TO
SCALE)

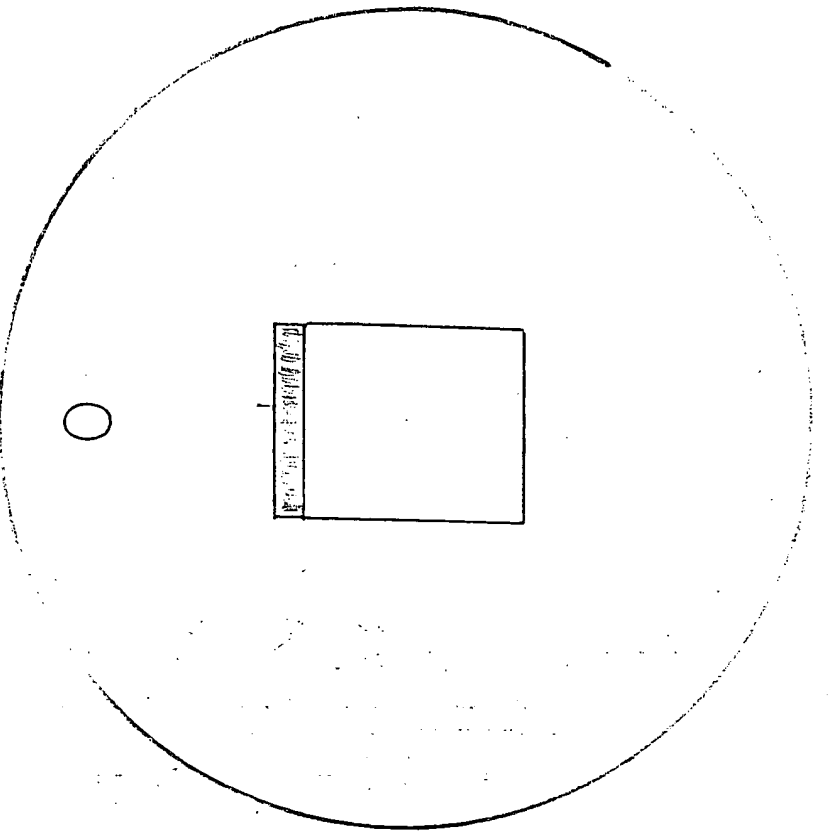


FRONT VIEW

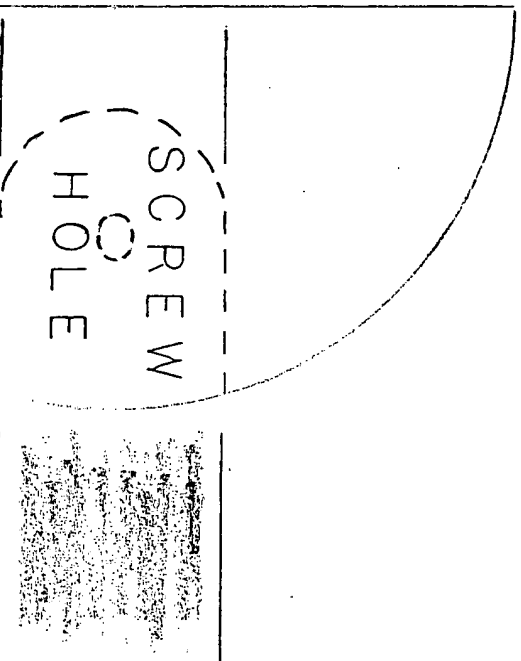
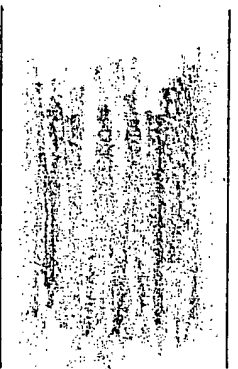


SIDE VIEW

DIAGRAM A



BACK VIEW

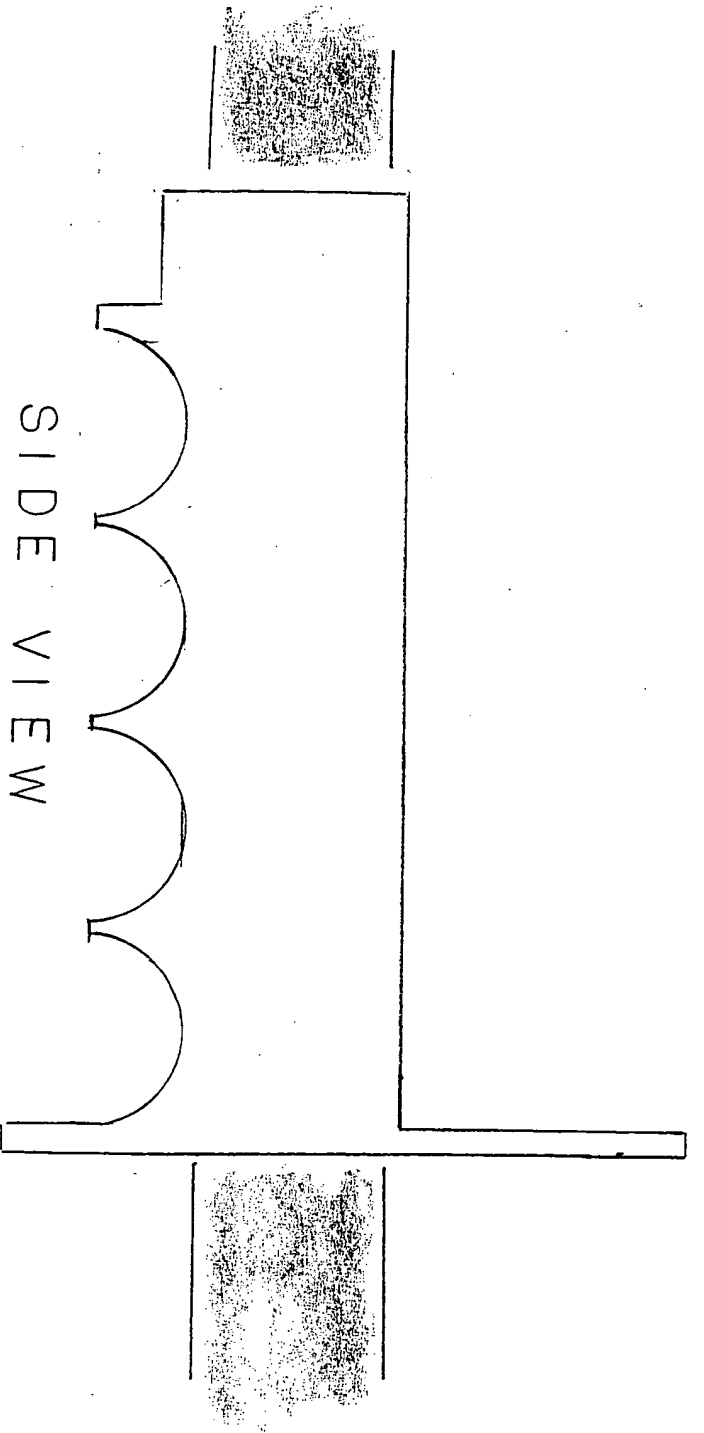


SCREW
HOLE

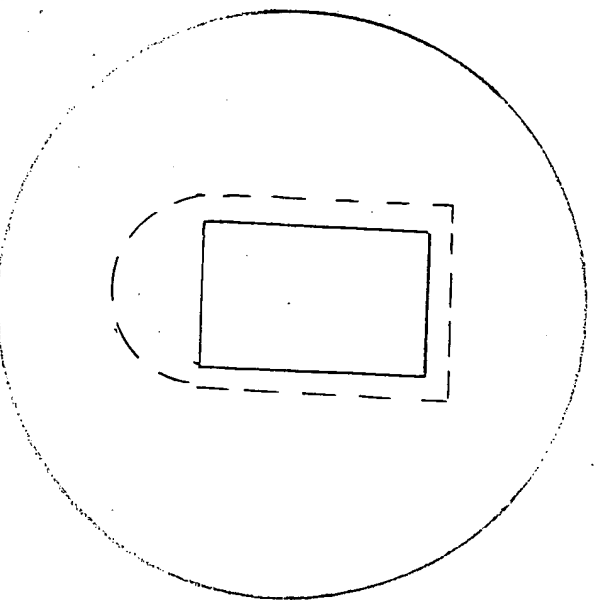
INSIDE
PIECE
OF CUP

DIAGRAM B

BOTTOM VIEW



SIDE VIEW



FRONT VIEW

DIAGRAM C



SPORTIME

CHIME TIME

AbilitATIONS

Senior Products



Spordas
INNOVATIONS IN SPORT

RAGBALL

activeminds

May 9, 2002

Mr. Jeffrey L. Frost
LaBelle High School
4050 Cowboy Way
LaBelle, FL 33935

Dear Mr. Frost,

Thank you for your letter of April 17th regarding your new Hockey Safety Hand Cup to Barry Traub, our Senior VP of New Product Development. Mr. Traub is on a three week trip to the Orient and Europe for product development. Once he returns to the office, this item will be reviewed by him and he will be in touch with you regarding our interest in your product.

I apologize for the delay in us responding to you, but do believe your new product idea is worth our consideration.

We appreciate your interest in working with Sportime and again, I apologize for this long delay.

Sincerely,

Peter Savitz
President

ONE SPORTIME WAY
ATLANTA, GA
30340-1402

tel. 770-449-5700
fax. 770-263-0897



SPORTIME

CHIME TIME

AbilitATIONS

SPORTIME Senior Products

 **JUGGLEBUG**

Spordas
INNOVATIONS IN SPORT

RAGBALL

activeminds

June 4, 2002

Jeffrey Frost

LaBelle High School

4050 Cowboy Way

LaBelle, FL 33935

Thank you for entrusting us with your creative idea. After careful evaluation, we have found that your submission does not meet one or more of the criteria, needed for acceptance. Some of those criteria are listed below.

Sportime develops and introduces more product innovations each year, than all the other physical education equipment companies in the world, put together. Even so, the ever increasing number of quality product ideas submitted to us from professionals like yourself, when added to the product ideas we generate internally, far exceed both our manufacturing and marketing capabilities. For that reason, a very strict set of criteria has been established. Though everything begins with the educational values of the concept, these criteria go well past them. Here are just a few:

1. What Age group is the concept targeted at? We look for products that are suitable for all students, grades, K - 8. A larger market has a greater chance of success.
2. What are the practical and philosophical elements of the concept? Is it or can it be made inclusive?" Is it applicable for "Bodily/Kinesthetic Learners?"
3. Are the majority of the concept's components equipment, vs. programming and is that equipment, unique enough to provide protection against being copied.
4. What physical and financial resources are required to manufacture the program's elements?
5. Can the components be protected?
6. Is the idea truly new or has it been submitted or manufactured before? We have received as many as three submissions of the same idea, in the same week.

These are only a few of the bars that a product concept must clear, just to make it through the initial analysis. There are many more, before a concept can become a Sportime Innovation. The original material you submitted to us, is enclosed. Should you feel that a future concept meets these criteria, please feel free to submit it.

Sincerely:



Barry Traub

Sr. Vice President

New Product Development

ONE SPORTIME WAY
ATLANTA, GA
30340-1402

tel. 770-449-5700
fax. 770-263-0897

LABELLE HIGH SCHOOL
4050 COWBOY WAY
LABELLE, FL 33935
PHONE: (863) 674-4120
FAX: (863) 674-4571

ADMINISTRATION:

Paul Puletti, Principal
Janice Foster, Assistant Principal
John Miller, Dean of Students
Vicki Chipman, Guidance Counselor
Bobbie Spratt, Guidance Counselor

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DATE: July 10, 2004 Number of pages including cover sheet: 6
To: DAVID BERGASH Fax # 716-694-0462
From: Jeff Frost Re: IDEA For Floor Hockey Add-on.

Note:

July 10, 2002

Dear Mr. Berghash,

Per our phone conversation yesterday, I am sending you information on my idea for a safety add on for Floor Hockey sticks. I came up with this idea several years ago but only recently felt inclined to act on it. In our first discussion, I mentioned that I initially submitted this idea to Sportime in April 2002. Below I will give a brief summary of how and why I think this product will work.

From years of playing Floor Hockey in Public School Physical Education classes, and now as a Physical Education Teacher (fifteen years middle and High School), I frequently see the need for some kind of hand protection. Most importantly for the bottom hand holding the stick. All too often during play while two opposing players are going for the puck (or ball) one stick will ride up on the other and hit the player in the hand (usually causing a scrape or bruise on the finger(s) and or knuckle). Besides the obvious pain a player (student) endures, you also have those students who will be reluctant to participate because of this problem.

It is my proposal for you to make a low cost, plastic cup or hand shield that can be used for both safety and as a guideline for hand placement. This device can be simply screwed or slid on (like a new blade) at an appropriate spot on the stick (for the lower hand) according to age level by the instructor. This "add on" would be both simple and safe.

Also, I noticed in the last Sportime catalog that they now offer protective gloves at ~ \$30.00 a pair. With the limited Physical Education budgets available today, it would cost almost \$300.00 to outfit two teams (and that does not include the goalies). At a cost of perhaps one-third or more of that of the gloves, this device (as yet unnamed) would be more economical for use in today's Physical Education and Recreation classes.

Furthermore, you have a health issue when numerous individual hands are sweating from activity inside these gloves. They would be hard to clean and not many kids would want to put on wet gloves that somebody else has used.

Thank you for your time in considering my idea,



Jefrey L. Frost
Teacher/Coach
LaBelle High School
4050 Cowboy Way
LaBelle, FL 33935
(W) 863-674-4120
(H) 863-675-2988
frost_j@popmail.firn.edu

Attached please find rough drawings with instructions for this device.

Instructions for Diagrams
(Not to size or scale)

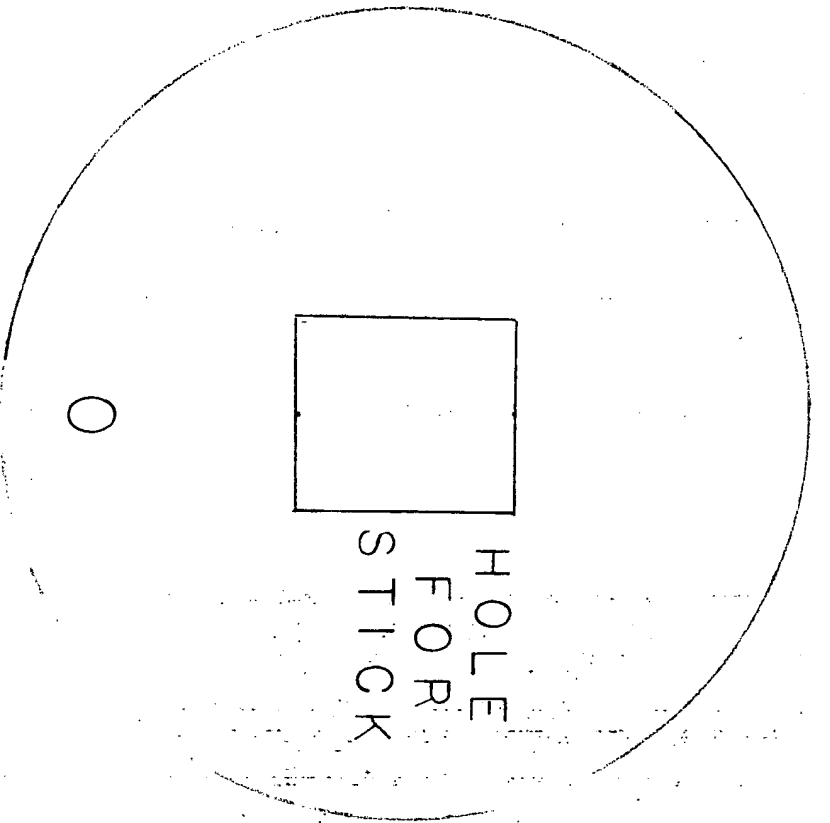
Diagram A: FRONT VIEW of "Cup" simply shows hole for stick. It also shows a hole at its base large enough for a standard screwdriver to fit through. SIDE VIEW of "Cup" shows a see through view of inside piece that attaches to the Hockey Stick by a screw.

Diagram B: BACK VIEW again shows hole for Hockey Stick, hole for screwdriver and, straight on view of inside attachment to be screwed to stick. BOTTOM VIEW shows cut away view of cup, showing inside piece of cup that is screwed on to Stick.

The "cup" could be slid over the back end of the stick. Another possibility would be to separate (cut) the lower half of the "Cup" and simply slide it over the back of the stick and securely refasten it back together and to the stick.

Lastly, I think a minimum diameter for the cup or shield should be about 6-7 inches across to protect the hand and knuckles.

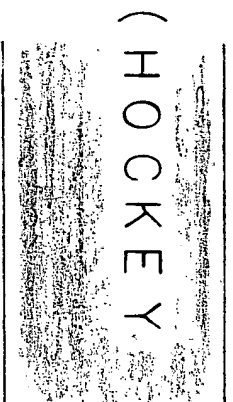
Diagram C: SIDE VIEW shows a one-piece flexible rubber grip with small shield in front that can be slid over the back end of a Hockey Stick. It would fit snugly on the stick, and would be slid down (may need to add water for lubrication) to the appropriate spot. FRONT VIEW simply shows the front view, with cut out of handgrip. Note that the shield part of this piece is flat and not curved like the "Cup" in Diagrams A and B.



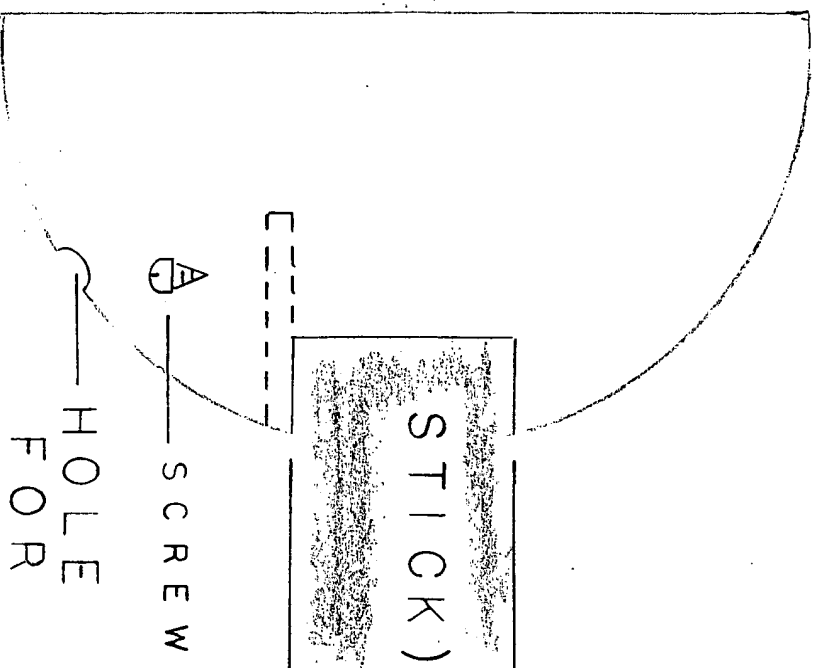
FRONT VIEW

DIAGRAM A

(DRAWINGS NOT TO
SCALE)



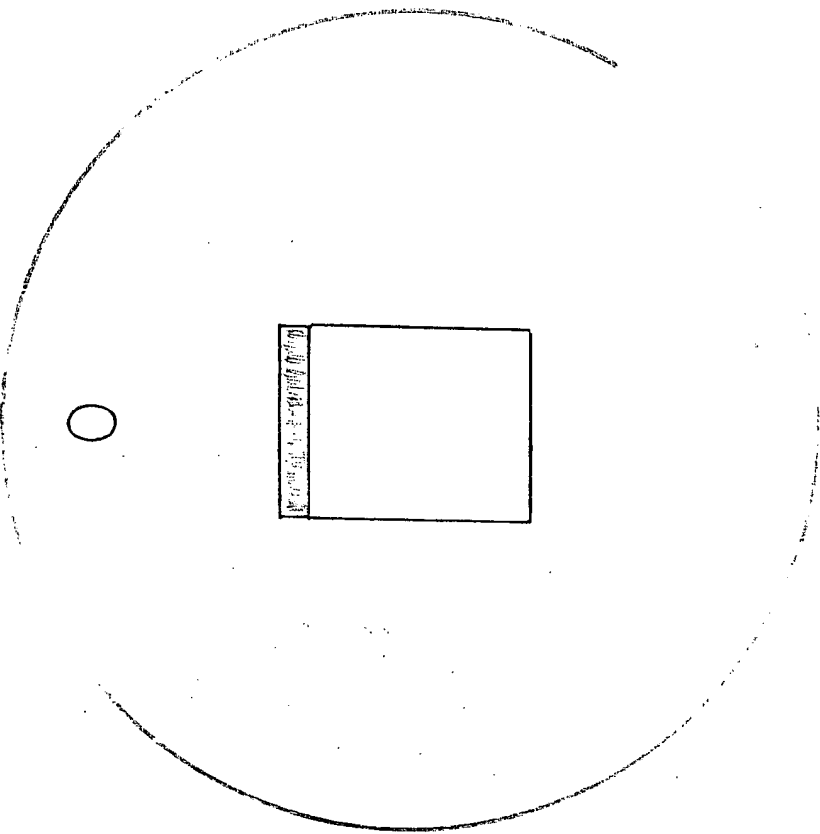
(HOCKEY)



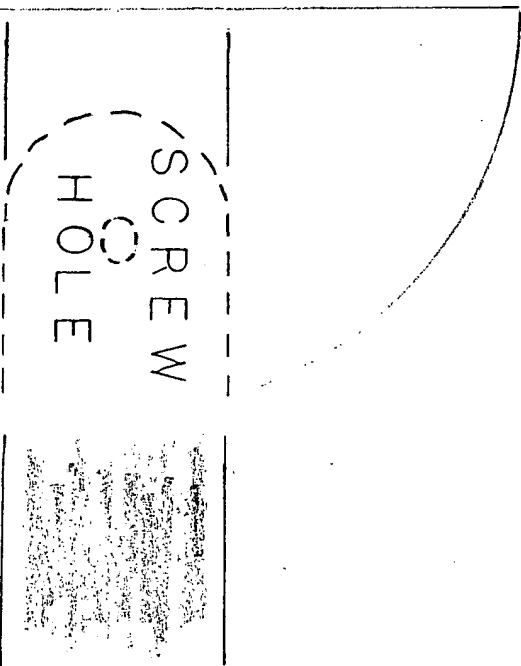
STICK)

A — SCREW

SIDE VIEW
HOLE FOR SCREW-DRIVER



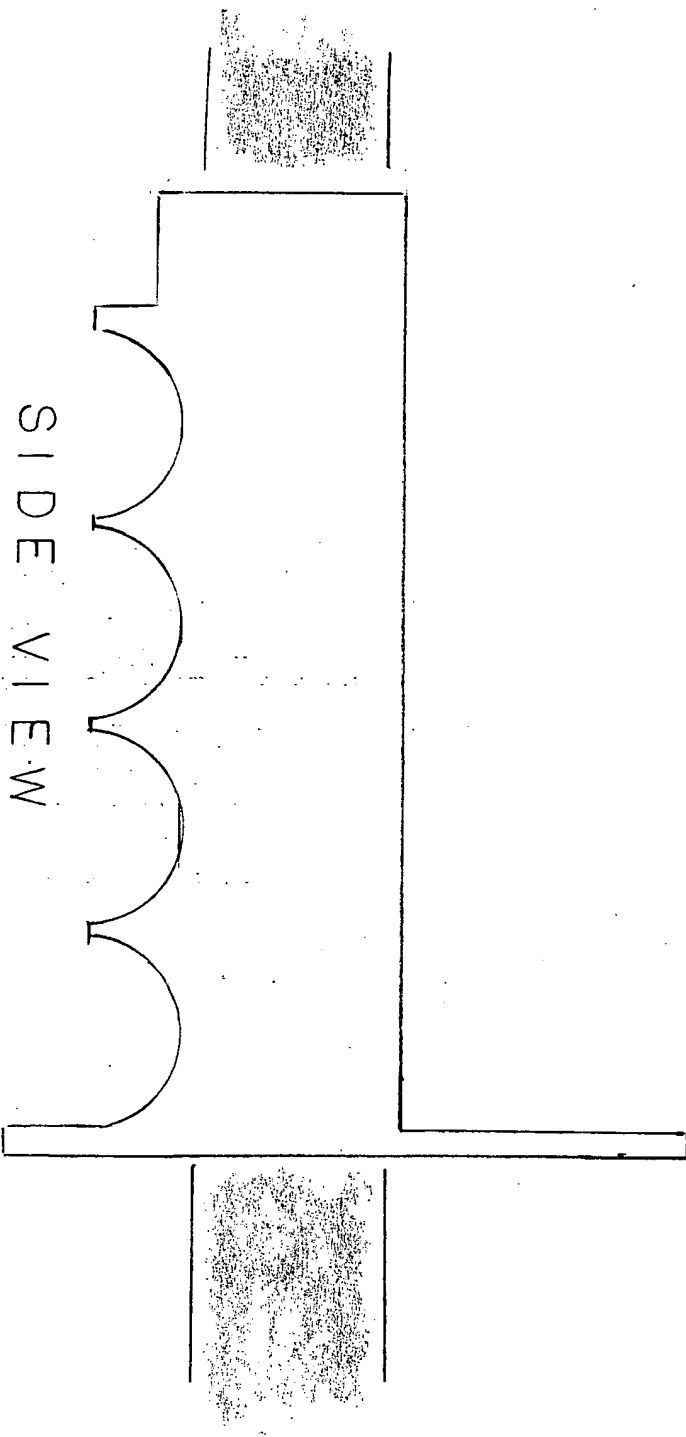
BACK VIEW



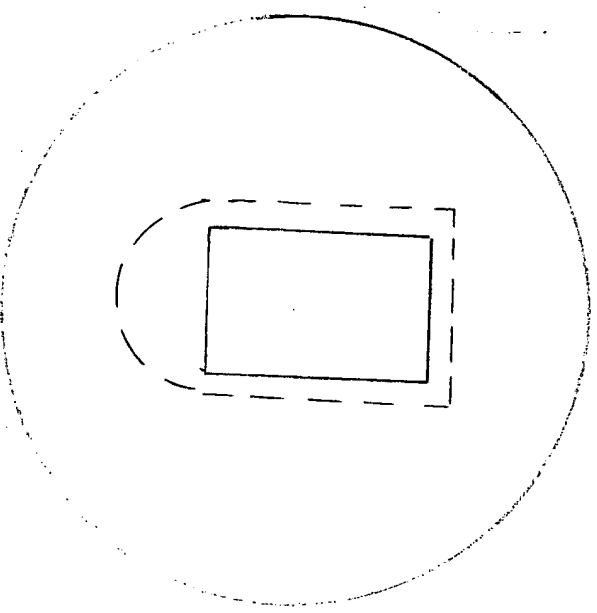
INSIDE
PIECE
OF CUP

DIAGRAM B

BOTTOM VIEW



SIDE VIEW



FRONT VIEW

DIAGRAM C

Jef Frost

From: Robert Berghash [rberghash@shieldsports.com]

Sent: Tuesday, December 03, 2002 6:53 AM

To: Jef Frost

Subject: Hockey hand Guard

Dear Jef: I have made up two samples of concepts for the Hand Guard. These are rough samples which utilized existing parts which are available. I made these to get an idea if the concept works. I will send these to you via overnight service today. One is too small and the other too big. In addition, I used a nylon cord as a finger loop.

I have given the concept to two molders of rubber parts, and they can make this product in one piece instead of a separate finger loop. At this point, our designer/engineer is ready to make drawings. However, I thought you should give these rough samples a try and feedback information before we spend money on the drawings. When you receive the samples, give me a call so I can explain what the differences between the samples and a production molded piece will be. (800 828 7669 Ext.310) We need to be careful because a mold for this can cost as much as \$20,000.

In addition, as soon as you give these samples a trial, I will need you to send them back with your comments. I look forward to hearing from you.

Thanks, Bob

1/13/2003

Jef Frost

From: Robert Berghash [rberghash@shieldsports.com]

Sent: Tuesday, December 17, 2002 9:11 AM

To: Jef Frost

Subject: Hand Guard

Dear Jef: We have made several samples of the hand guard for testing similar to the ideas we discussed. The best diameter is about 5 inches with a short tube over the shaft of the stick. A longer tube is bulky. With a shorter tube (about 1 inch) the user puts only the thumb and forefinger on the tube of the guard and the rest of the hand grips the hockey shaft. There was no problem with the skin getting caught when the guard moved up and down the shaft.

We are have drawings made which I will send you. We will have a hard sample made directly off a computer disc. The final product can be tested in a variety of materials from very hard to very soft. I guess that the finished product will be semi-soft like Tupperware.

Let me know your thoughts or give me a call. Thanks, Bob

Agreement
w/ Shield
10/15/02

EXCLUSIVE LICENSE AGREEMENT

AGREEMENT made this 11th day of October, 2002, between Jeffrey Frost, 4050 Cowboy Way, LaBelle, FL 33935, hereinafter called "Licensor" and Shield Mfg. Inc., 425 Fillmore Ave., Tonawanda, NY 14150, a Delaware corporation, hereinafter called the "Licensee".

WITNESSTH:

WHEREAS, the Licensee desires to manufacture, use and sell; the Hockey Hand Guard hereinafter called the Guard; and

WHEREAS, the Licensee shall have the right to market said Guard;

IT IS THEREFORE AGREED:

1. **Exclusive License:** The Licensor hereby grants to the Licensee the exclusive right and license in the United States and Canada, to manufacture, use and sell the Guard.
2. **Alterations and Improvements:** The Licensee shall be entitled to alter or to improve the Guard and may apply for any patent for the improvement on the Guard. The Licensee shall retain the right, title and interest to such improvement and any such patent, patent application or invention.
3. **Royalties:** The Licensee shall pay the Licensor a royalty of 4% of the net sales (or 5.5% of the net sales in the case the licensor applies for and receives a patent) obtained from the manufacture and sale of such Guard. Net sales are defined as gross sales less returns and discount allowances. Net sales are calculated prior to deductions for cost of goods, operational and marketing and sales expenses. The Licensee shall keep an accurate account of the operations coming under the scope of its license and shall render a statement in writing to the Licensor within thirty (30) days after any quarterly period of each calendar year during the term of this Agreement, and shall pay the Licensor the amount of earned royalties accrued on a monthly basis during the quarterly period. The licensor shall have the right, at his own expense and not more than once each quarterly period, to examine the books of the Licensee to verify the royalty statements of the operations coming under this scope of this Agreement.
4. **Term:** The term of this agreement shall be twelve (12) years, but subject to the following:
 - a) If the Licensee fails to render statements or to make payments of royalties as herein provided, the licensor may on thirty (30) days written notice to the Licensee terminate this agreement. If such default is not cured within

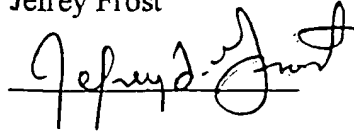
thirty (30) days period, this Agreement shall terminate on the date set in such notice without prejudice, however, to the monies due to the Licensor hereunder.

- b) If the Licensee shall abandon the exploitation of the Guard by failing for a period of six (6) months, or such longer period of time as may be agreed upon by the parties, to manufacture, sell, ship or distribute the Guard, for any reason other than an Act of God, the Licensor may on thirty (30) days written notice to the Licensee terminate this Agreement without prejudice, however, to the monies due to the Licensor hereunder. It is understood that sales during the first year will grow slowly due to the fact that the introduction into school catalogs takes time to establish.

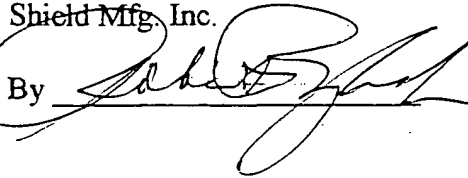
5. **COVENENT AND INDEMNITY:** The Licensor covenants and agrees that he shall not directly or indirectly engage in or become financially interested in, or otherwise associated with any person or persons, firms or corporations which shall compete with the Licensee in relation to the manufacture and sale of any Guard device in the field of recreational and athletic equipment, within the United States or Canada for a period of 12 years from the date of this agreement.
6. **ASSIGNMENT:** The Licensee shall have the full right and authority to assign this License in whole or part or to grant Licenses thereunder to any person, firm or corporation, provided, however, that any such assignee must acknowledge, in writing, his or its acceptance of the terms and conditions of this Agreement, including all financial obligations hereunder.
7. **EXCLUSIVE LICENSE:** The License hereby granted shall be exclusive with the Licensee, and the Licensor hereby covenants and agrees that he will not during the term of this License grant any License or other rights in the said Guard to any person, firm or corporation. The Licensor shall, upon demand, execute and deliver to the Licensee such documents as may be deemed necessary or advisable by counsel for the Licensee for filing in the appropriate patent office(s) to evidence the granting of the exclusive License hereby given.
8. **BENEFIT:** This agreement shall be binding upon and inure to the benefit of the heirs, legal representatives, successors and assigns of the parties hereto.
9. **GOVERNING LAW:** This agreement shall be governed by and shall be construed in accordance with the laws of the State of New York.

IN WITNESS WHEREOF, the parties hereto have executed this Agreement the day
and year first above written.

Jeffrey Frost

A handwritten signature in cursive script, appearing to read "Jeffrey Frost", written over a horizontal line.

Shield Mfg. Inc.

By  - 10/15/02

A handwritten signature in cursive script, followed by a horizontal line and the date "10/15/02".

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